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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,637	12/29/2003	Syed Rizvi	001-265	1636
29569	7590	12/27/2005		
JEFFREY FURR 253 N. MAIN STREET JOHNSTOWN, OH 43031			EXAMINER TOY, ALEX B	
			ART UNIT 3739	PAPER NUMBER

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/707,637	RIZVI, SYED
	<b>Examiner</b>	<b>Art Unit</b>
	Alex B. Toy	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 November 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
  - 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 15-17 is/are rejected.
- 7) Claim(s) 16 and 17 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to applicant's amendment filed on November 15, 2005.

### ***Claim Objections***

Claims 16 and 17 are objected to because of the following informalities: Claims 16 and 17 depend from claim 1, a canceled claim. For the purposes of examination, it is assumed that applicant intended claims 16 and 17 to depend from claim 15.

The claims are objected to because the lines are crowded too closely together, making reading difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As stated in the previous 35 U.S.C. 112 rejection of canceled claims 2 and 9, claim 16 recites no structure. An ergonomically efficient design is indefinite and the rest

of the claim is intended use. Therefore, it is unclear what is being claimed and what the applicant regards as the invention.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tischer (U.S. Pat. No. 4,655,216) in view of Ryan (U.S. Pat. No. 6,152,923).

Regarding claim 15, Tischer discloses a laparoscopy instrument comprising:  
a shaft 8 connecting a proximal end and a distal end (Figs. 1 and 2);  
a handle 1 on said proximal end, said handle attached via plug device 7 to a power source for bipolar electrocautery (col. 1, ln. 7-9 and col. 4, ln. 25-28) with said handle housing embodiments 2 and 3 to engage cautery means B and cutting means F (Figs. 1 and 2);

a tip on said distal end, with said tip housing one fixed jaw A and two movable jaws B and F (col. 4, ln. 36-39), said fixed jaw A and one movable jaw B connected via conductors N and O to said power source for bipolar cautery via plug device 7 in said shaft (col. 4, ln. 28-30 and col. 4, ln. 40-41), the other movable jaw F is a cup shape cutting jaw connected to said handle via said shaft with pull rod H attached to a movable part of the handle 3 and is connected to the cutting jaw F in the distal portion J of the device (col. 4, ln. 49-51) with the forward movement of said movable part of the handle

3 opening the cutting jaw F (Fig. 2 – jaw F moves upwards into the open position, col. 4, ln. 51-53) and backward movement closing said cutting jaw F (not shown – jaw F moves downward into grasping device A, col. 4, ln. 53-54).

See Figs. 1 and 2. Regarding the cup shape, the cutting jaw forms a convex cup shape as seen in the side view in Fig. 2.

The claim differs from Tischer in calling for a shaft rotation means. Ryan, however, teaches a laparoscopic instrument for bipolar electrocautery and cutting comprising a shaft rotation means 24 for controlling the rotational movement of the forceps about a longitudinal axis (col. 4, ln. 45-48 and Fig. 1A). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tischer to include a shaft rotation means in view of the teachings of Ryan for controlling the rotational movement of the forceps about a longitudinal axis.

Regarding claim 16, Tischer discloses the instrument of claim 15 in view of Ryan. Tischer also teaches an ergonomically efficient embodiment that allows the surgeon to use the middle finger for an additional step during a surgical procedure without moving or repositioning the fingers. The middle finger can be used to actuate handle 3 to move cutting jaw F without moving the other fingers from handle 2 which controls movable jaw B for bipolar electrocautery (col. 4, ln. 23-24, col. 4, ln. 50-51, and Figs. 1 and 2).

Regarding claim 17, Tischer discloses the instrument of claim 15 in view of Ryan. In addition, Tischer discloses the instrument further comprising said moving handle 3 is for positioning fourth and fifth fingers. The Office maintains that claim 15 is an intended use limitation without any structural limitation that defines over Tischer in view of Ryan.

Furthermore, the instrument of Tischer is inherently capable of having said moving handle 3 for positioning fourth and fifth fingers, whether it was originally intended to be used that way or not.

***Response to Arguments***

Applicant's arguments with respect to claims 15-17 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

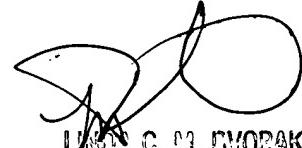
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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12/12/05



LINDA C. M. DVORAK  
SUPERVISOR - PATENT EXAMINER  
FEB 12 2006